

5658

HAND CARRY TO THE PCT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re the application of:

CUNNINGHAM, et al.

Serial Number: 09/701,395

Filed: June 2, 1999

For: GENES OF CAROTENOID BIOSYNTHESIS AND METABOLISM AND  
METHODS OF USE THEREOF

**REQUEST FOR CORRECTION OF PATENT OFFICE RECORDS AND  
RECONSIDERATION OF ERRONEOUS HOLDING OF MISSING PARTS**

Commissioner for Patents  
Washington, D.C. 20231

September 25, 2001

Sir:

A Third Notification of Missing Requirements (copy attached) was mailed from the U.S. Patent and Trademark Office to the firm of Arent Fox Kintner Plotkin and Kahn, PLLC. on July 11, 2001. A Fourth Notification of Missing Requirements (copy also attached) was mailed on July 25, 2001.

However, contrary to each of the Notifications, a first Response to Notification of Missing Requirements was filed on June 18, 2001 containing the declaration, an assignment document for recording along with the 1 595 form, and a Preliminary Amendment. A second Response to Notification of Missing Requirements was filed on July 2, 2001 containing a Statement under 37 CFR §1.821(c), a Sequence Listing in computer readable form and paper copy. Attached please find a copy of the filing from

June 18, 2001 and July 2, 2001 along with the applicants' attorneys' return-receipt postcard.

In view of the foregoing, the applicants respectfully request that the U.S. Patent and Trademark Office's records be corrected to show that a proper response was timely filed.

Any fees associated with this communication should be waived since the evidence submitted herewith shows that the applicants are in no way at fault, and a timely response was filed.

The Commissioner is hereby authorized to charge any fees associated with this communication to Deposit Account No. 01-2300. A duplicate copy of this request is attached.

Should the appropriate official of the U.S. Patent and Trademark Office have any questions, that official is requested to telephone the applicants' undersigned attorney.

Respectfully submitted,  
ARENTH FOX KINTNER PLOTKIN & KAHN



Richard J. Berman  
Attorney for Applicant(s)  
Reg. No. 39,107

1050 Connecticut Avenue, N.W., Suite 400  
Washington, D.C. 20036-5339  
Tel: (202) 857-6000

RJB:ccd

Enclosures: Copies of the Notifications of Missing Requirements / postcard receipts / Responses to the Notification of Missing Requirements (as filed on June 18, 2001 and June 2, 2001)



## UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents, Box PCT  
United States Patent and Trademark Office  
Washington, D.C. 20231  
[www.uspto.gov](http://www.uspto.gov)

U.S. APPLICATION NO.

09/701395

FIRST NAMED APPLICANT

CUNNINGHAM

ATTY. DOCKET NO.

P108172-0002

F

INTERNATIONAL APPLICATION NO.

PCT/US99/12121

I.A. FILING DATE

02 JUN 99

PRIORITY DATE

02 JUN 98

DATE MAILED:

11 JUL 2001

RENT FOX KINTNER PLOTKIN & KAHN  
SUITE 600  
1050 CONNECTICUT AVENUE NW  
WASHINGTON, DC 20036 5339

108172-0002

Sept 11/2001

11 JUL 2001

## NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

1. The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as  a Designated Office (37 CFR 1.494)  an Elected Office (37 CFR 1.495):

U.S. Basic National Fee.  Indication of Small Entity Status.  
 Copy of the international application.  Translation of the international application into English. Received  
 Oath or Declaration of inventors(s).  Translation of Article 19 amendments into English.  
 Copy of Article 19 amendments.  Other:  
 Priority Document.

The International Preliminary Examination Report in English and its Annexes, if any.  
 Translation of Annexes to the International Preliminary Examination Report into English.

2.  Applicant has requested early processing under 35 U.S.C. 371(f) but has not filed the following indicated items and/or the indicated items in paragraph 3 below. The Basic National Fee and the copy of the international application must be filed prior to 20 or 30 months from the priority date to avoid abandonment.

U.S. Basic National Fee.  Copy of the international application.

3. The following items MUST be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

a.  Translation of the application into English. A processing fee will be required if submitted later than the appropriate 20 or 30 months from the priority date.  
 The current translation is defective for the reasons indicated on the attached Notice of Defective Translation.

b.  Processing fee for providing the translation of the application and/or the Annexes later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(f)).

c.  Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), properly identifying the application (preferably by the International application number and international filing date). A surcharge will be required if submitted later than the appropriate 20 or 30 months from the priority date.

d.  The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917.

d. Surcharge for providing the oath or declaration later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(e)).

4. Additional claim fees of \$\_\_\_\_\_ as a  large entity  small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due (37 CFR 1.492(g)). See attached PTO-875.

5.  Applicant has not submitted the required sequence listing pursuant to 37 CFR 1.821-1.825. See attached PCT/DO/EO/920.

ALL OF THE ITEMS SET FORTH IN 3(a)-3(d), 4 AND 5 ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 22 OR 32 MONTHS (where 37 CFR 1.495 applies) FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

6. If box 3a or 3c is checked, a translation of the Annexes MUST be submitted no later than the time period set above or the Annexes will be cancelled. A processing fee will be required if submitted later than 20 or 30 months from the priority date.

7.  The Article 19 amendments are cancelled since a translation was not provided by the appropriate 20 (37 CFR 1.494(d)) or 30 (37 CFR 1.495(d)) months from the priority date.

Applicant is reminded that any communication to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above. (37 CFR 1.5)

*A copy of this notice MUST be returned with this response.*

Enclosed:  PCT/DO/EO/917  
 PTO-875

Notice of Defective Translation  
 PCT/DO/EO/920

Lamont Hunt r

Telephone: 703-305-3686



## UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents, Box PCT  
United States Patent and Trademark Office  
Washington, D.C. 20231  
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U.S. APPLICATION NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/701395	CUNNINGHAM	F P108172-0002
INTERNATIONAL APPLICATION NO.		
PCT/US99/12121		
I.A. FILING DATE	PRIORITY DATE	
02 JUN 99	02 JUN 98	

AREN'T FOX KINTNER PLOTKIN & KAHN  
SUITE 600  
1050 CONNECTICUT AVENUE NW  
WASHINGTON, DC 20036 5339

Sept 11, 2001 DATE MAILED: 11 JUL 2001

**NOTIFICATION TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS  
CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE  
DISCLOSURES**

Applicant has submitted papers under 35 U.S.C. 371 to enter the national stage in the United States of America. The items indicated below, however, are missing. The period within which to correct the deficiency noted below and avoid abandonment is set forth in the accompanying Notification.

The nucleotide and/or amino acid sequence disclosure contained in this application does not comply with the requirements for such a disclosure as set forth in 37 CFR 1.821-1.825 for the following reason(s):

- The application fails to comply with the requirements of 37 CFR 1.821-1.825.
- This application does not contain, a "Sequence Listing" as a separate part of the disclosure on paper copy or compact disc, as required by 37 CFR 1.821(c).
- A copy of the "Sequence Listing" in computer readable format has not been submitted as required by 37 CFR 1.821(e).
- A copy of the "Sequence Listing" in computer readable form has been submitted. The content of the computer readable form, however, does not comply with the requirements of 37 CFR 1.822 and/or 1.832, as indicated on the attached marked-up copy of the "Raw Sequence Listing."
- The computer readable form that has been filed with this application has been found to be damaged and/or unreadable as indicated on the attached CRF Diskette Problem Report. A substitute computer readable form must be submitted as required by 37 CFR 1.825(d).
- The paper copy or compact disc of the "Sequence Listing" is not the same as the computer readable form of the "Sequence Listing" as required by 37 CFR 1.821(e).
- Other: \_\_\_\_\_

**APPLICANT MUST PROVIDE:**

- An initial or substitute computer readable form (CRF) of the "Sequence Listing."
- An initial or substitute paper copy or compact disc of the "Sequence Listing," as well as an amendment directing its entry into the specification.
- A statement that the contents of the paper or compact disc and the computer readable form are the same and, where applicable, include no new matter, as required by 37 CFR 1.821(e), 1.821(f), 1.821(g), 1.825(b) or 1.825(d).

**FOR QUESTIONS REGARDING COMPLIANCE WITH THESE REQUIREMENTS, PLEASE  
CALL:**

- (703) 308-4216, for Rules interpretation,
- (703) 308-4212, for CRF submission help,
- (703) 287-0200, for PatentIn software help.

Lamont Hunter

Telephone: 703-305-3686



UNITED STATES PATENT AND TRADEMARK OFFICE

CPI

Commissioner for Patents, Box PCT  
United States Patent and Trademark Office  
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SUITE 600  
1050 CONNECTICUT AVENUE NW  
WASHINGTON, DC 20036 5339

I.A. FILING DATE	PRIORITY DATE
02 JUN 99	02 JUN 98

DATE MAILED: 25 JUL 2001

MB 108172-00022 Sept 25 2001  
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 The International Preliminary Examination Report in English and its Annexes, if any.  
 Translation of Annexes to the International Preliminary Examination Report into English.

**Received**

JULY 30 2001

**Arent Fox**

2.  Applicant has requested early processing under 35 U.S.C. 371(f) but has not filed the following indicated items and/or prior to 20 or 30 months from the priority date to avoid abandonment.

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 c. Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), properly identifying the application (preferably by the International application number and international filing date). A surcharge will be required if submitted later than the appropriate 20 or 30 months from the priority date.  
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*A copy of this notice MUST be returned with this response.*

Enclosed:  PCT/DO/EO/917       Notice of Defective Translation  
 PTO-875       PCT/DO/EO/920

FORM PCT/DO/EO/905 (March 2001)

Lamont Hunter  
Telephone: 703-305-3686  
DOCKETED BY *[Signature]*  
DATE *[Signature]*



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United States Patent and Trademark Office  
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Jameson Hunter

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